

AF/ 1754
JFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:
J. Yong Ryu

Serial No.: 09/977,666

Filed: 10/15/01

§
§
§
§
§
§
§

Atty. File: CDT 1792

Group Art Unit: 1754

Examiner: C.N. Nguyen

FOR: Hydrogenation Catalyst and Hydrogenation Process

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL

[X] REPLY BRIEF (in triplicate)

Respectfully submitted,

Kenneth H. Johnson
Reg. No. 22,966
P.O. Box 630708
Houston, Texas 77263
Tel. (713) 780-7047
FAX No. (713) 780-7671

Date: 06/04/04

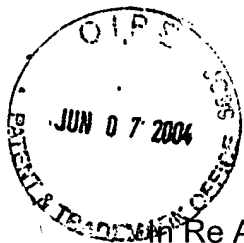
CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

on 06/04/04

Kenneth H. Johnson



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Re Application of:
J. Yong Ryu

Serial No.: 09/977,666

Filed: 10/15/2001

For: HYDROGENATION CATALYST AND HYDROGENATION PROCESS

§ Atty File: CDT 1792

§

§

§

§ Group Art Unit: 1754

§

§ Examiner: C. N. NGUYEN

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

This paper is presented in response the to EXAMINER'S ANSWER mailed on May 4, 2004, to answer the examiner's new points of arguments (1) that the incidental disclosures of discretionary components in Frenzel are sufficient to create anticipation; (2) that Pd is a required element in all of the Frenzel compositions; and (3) that the consideration of the claims together does not require the examiner to consider each claim or in some manner voids an issue on appeal.

(1) Claim 1 the broadest claim covers 27 compositions of required components as set out in the following table.

CLAIM 1 ON APPEAL

1. (A) Pd and 2 of Ag, Zn and Ru.

(B) Pd + one other group 8 metals and 2 of (Ag, Zn & Bi)

SPECIFIC COMPOSITIONS OF REQUIRED COMPONENTS AS SET OUT IN CL. 1

(A) (1) Pd + Ag + Zn
(2) Pd + Ag + Bi

(3) Pd + Zn + Bi

- (B) (4) Pd + Fe + Ag + Zn
(5) Pd + Fe + Ag + Bi
(6) Pd + Fe + Zn + Bi
(7) Pd + Co + Ag + Zn
(8) Pd + Co + Ag + Bi
(9) Pd + Co + Zn + Bi
(10) Pd + Ni + Ag + Zn
(11) Pd + Ni + Ag + Bi
(12) Pd + Ni + Zn + Bi
(13) Pd + Ru + Ag + Zn
(14) Pd + Ru + Ag + Bi
(15) Pd + Ru + Zn + Bi
(16) Pd + Rh + Ag + Zn
(17) Pd + Rh + Ag + Bi
(18) Pd + Rh + Zn + Bi
(19) Pd + Os + Ag + Zn
(20) Pd + Os + Ag + Bi
(21) Pd + Os + Zn + Bi
(22) Pd + In + Ag + Zn
(23) Pd + In + Ag + Bi
(24) Pd + In + Zn + Bi
(25) Pd + Pt + Ag + Zn
(26) Pd + Pt + Ag + Bi
(27) Pd + Pt + Zn + Bi

The examiner urges that the paragraph at col. 6, lines 23-36, set out here for convenience¹, provides a sufficient disclosure of Zn to be incorporated with the specific disclosure of Frenzel to anticipate claims. However, the Zn is disclosed as an example of a discretionary promoter in a list of 14 other elements also listed by name (and possibly

¹"The catalyst can, if necessary or desired, further comprise other elements than the metals of the 10th and 11th groups of the Periodic Table of the Elements in its active composition. In particular, it may comprise customary promoters. Frequently used promoters are, for example, the alkali metals and alkaline earth metals, e.g. lithium, sodium, potassium, rubidium, cesium, magnesium, calcium, strontium and/or barium, and the elements of the 3rd group, e.g. gallium and/or indium, or other promoters such as zinc or fluoride. Type and amount of such promoters need to be optimized in a customary manner for the individual case; in general, the amounts of such promoters added are in the range from a few ppm by weight to a few thousand ppm by weight."

double that by generic description) for the same purpose. The list of discretionary promoters contains, by name, 2 more elements than *appellant's required list* in board claim

1. It is appears to the examiner's position that it is appropriate to selectively use any discretionary element from the list of 14 to become a component of the required elements of the reference without any suggestion from the reference as to how this would become the present invention. The examiner mistakenly randomly selected bits and pieces from different portions of the same reference as parts list to recreate the present claimed invention. "an 'anticipating' reference must describe all of the elements and limitations of the claim in a single reference, and *enable one* skilled in the field of the invention to make and use the claimed invention" (emphasis added) *Merck & Co. Inc. v. Teva Pharmaceuticals USA Inc.*, 68 USPQ2d 1857,1861 (Fed. Cir. 2003); *Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc.*, 58 USPQ2d 1508 (Fed. Cir. 2001); *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913 (Fed. Cir 1989).

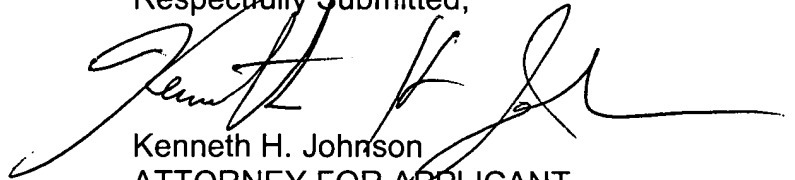
(2) Contrary to the examiners assertion Frenzel only teaches that "at least one" metal from group 10 (Ni, Pt or Pd) is required to be present in each composition. That metal may be Ni, Pt or Pd. Thus, Frenzel does not require that Pd be in each composition, whereas the present claims do.

(3) The examiner is incorrect in failing to address the rejection made in the final and set forth in ISSUE 3 IS CLAIM 8 OBVIOUS OVER FRENZEL U.S. PATENT 6,350,717 IN VIEW OF BROWN U.S. PATENT 6,127,310 UNDER 35 USC § 103(A)? The issue is a final rejection. If the examiner intends to withdraw the rejection then it need not be considered. Similarly, the failure of the prior art to teach the limitation of claim 12 has not

been abandoned by appellant because of the examiner's misstatement as to the information disclosed by the reference.

Applicant/appellant respectfully renews the request that the board reverse the examiner.

Respectfully Submitted,



Kenneth H. Johnson
ATTORNEY FOR APPLICANT
Reg. No. 22,966
P.O. Box 630708
Houston, Texas 77263
TEL: (713) 780-7047
FAX: (713) 780 7671

Date

06/04/04


CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

on

06/04/04



KENNETH H. JOHNSON